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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MAI, KEVIN S

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/538,435	<b>Applicant(s)</b> VAU ET AL.	
	<b>Examiner</b> KEVIN S. MAI	<b>Art Unit</b> 2456	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

1. This Office Action has been issued in response to Applicant's Amendment filed April 22, 2009.
2. Claims 10-12 have been canceled. Claims 1-9, 13 and 14 are pending in the application.

### ***Response to Arguments***

3. Applicant's arguments filed April 22, 2009, with respect to the rejection(s) of claim(s) 1-9, 13 and 14 under 35 USC § 102 and 35 USC § 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 7 recites the limitation "acknowledgments". There is insufficient antecedent basis for this limitation in the claim. Claim 7 is dependent on claim 1 and claim 1 does not disclose acknowledgements. Claim 6 appears to be the first claim that introduces acknowledgments.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claims 1, 3 and 7-9 are rejected under 35 U.S.C. 102(a) as being anticipated by US Pub. No. 2002/0032905 to Sherr et al. (hereinafter “Sherr”).

9. **As to Claim 1**, Sherr discloses **a method of image distribution from a central distribution server to at least one receiver device** (Paragraph [0009] of Sherr discloses providing access to an online catalog of a network video server computer to clients), **in which, in response to a user request** (Paragraph [0009] of Sherr discloses requests are then received from client computers for rental of digital video signals selected from the catalog), **at least one image is broadcast by a telecasting means** (Paragraph [0024] of Sherr discloses the transfer may be accomplished in various ways, including broadcast systems, cable system, satellite systems, broadcast television system, broadcast digital television systems or internet), **and an information message of image availability by telecasting is sent to the receiver device** (Figure 10 of Sherr discloses a download manager, wherein it is seen that the user has the ability to select start download. The appearance of this window is seen to be information of the availability of the video).

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10. **As to Claim 3**, Sherr discloses **a method according to Claim 1, wherein the image is encoded with at least one key before its broadcasting** (Paragraph [0088] of Sherr discloses that the server downloads an encrypted version of the digital video signals to the user computer).

11. **As to Claim 7**, Sherr discloses **a method according to Claim 1, wherein the availability information message and/or acknowledgement are messages transmitted by Internet** (Paragraph [0024] of Sherr discloses the transfer may be accomplished in various ways, including broadcast systems, cable system, satellite systems, broadcast television system, broadcast digital television systems or internet).

12. **As to Claim 8**, Sherr discloses **a method according to Claim 1, wherein the image is broadcast by radio and/or by cable** (Paragraph [0024] of Sherr discloses the transfer may be accomplished in various ways, including broadcast systems, cable system, satellite systems, broadcast television system, broadcast digital television systems or internet).

13. **As to Claim 9**, Sherr discloses **a method according to Claim 1, wherein the image distribution request is transmitted from the user to the central server using a surcharged electronic message** (Paragraph [0087] of Sherr discloses a client paying for a selected digital video signal to grant the client a license to view the selected digital video signal. This is seen to be a request that is a surcharged electronic message, since it is an electronic message that incurs a charge).

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***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

17. Claims 2, 4, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherr.

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18. **As to Claim 2**, Sherr discloses **a method according to Claim 1**. Sherr does not explicitly disclose **wherein the image to be broadcast is transmitted from the server to a telecasting station**.

However, such a feature would have been obvious in view of Sherr. Paragraph [0024] of Sherr discloses the transfer may be accomplished in various ways, including broadcast systems, cable system, satellite systems, broadcast television system, broadcast digital television systems or internet. Some of these methods require the video to be broadcast to be transmitted to a telecasting station. As such since Sherr discloses utilizing these transfer methods, it would be obvious to implement the other features that would be required to utilize those methods.

19. **As to Claim 4**, Sherr discloses **a method according to Claim 3**. Sherr does not explicitly disclose **wherein the key is sent to the receiver device with the availability information message**.

However, such a feature would have been obvious in view of Sherr. Paragraph [0101] of Sherr discloses the user has downloaded content from the network server computer to the user's computer while concurrently purchasing a license for the content. Thus it is seen that the action of selecting to download can occur concurrently with the purchasing of a license for the content. As such, since the actions are able to be performed concurrently it would be obvious for the two pieces of information to be sent at the same time.

20. **As to Claim 5**, Sherr discloses **a method according to Claim 1**. Sherr does not explicitly disclose **wherein transmission of the image to the telecasting station and**

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**transmission of the availability information message to the receiver device take place at the same time.**

However, such a feature would have been obvious in view of Sherr. Paragraph [0024] of Sherr discloses the transfer may be accomplished in various ways, including broadcast systems, cable system, satellite systems, broadcast television system, broadcast digital television systems or internet. Thus in the situations where systems like satellite are being used, in order for the download to occur when the user selects it, the information would need to be transmitted to the telecasting station at the same time. Thus such a feature is seen as obvious to try in view of Sherr's disclosure of using the various broadcast systems.

21. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sherr and further in view of US Pub. No. 2001/0056578 to Hwang et al. (hereinafter "Hwang").

22. **As to Claim 6, Sherr discloses a method according to Claim 1. Sherr does not explicitly disclose comprising a transmission by the receiver device, of an acknowledgement of the image and an interruption of the broadcasting of the image in response to the acknowledgement.**

However, Hwang discloses this. Paragraph [0034] of Hwang discloses when all information requested to the VOD (video on demand) terminal is downloaded or reproduction is finished a VOD service stop command is sent to the VOD server.

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the method of claim 1 as disclosed by Sherr, with sending a service stop command as



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disclosed by Hwang. One of ordinary skill in the art would have been motivated to combine to use a known technique to improve similar devices in the same way. Both Hwang and Sherr disclose systems dealing with video on demand; as such it would be obvious to implement features known in one video on demand system in another. This particular feature would improve the inventions by preventing the client and server from getting stuck expecting data from each other.

23. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pub. No. 2002/0071139 to Janik and further in view of Sherr.

24. **As to Claim 13**, Janik discloses **a digital photo frame comprising a network communication channel** (Paragraph [0060] of Janik discloses a digital photo frame being able to play data from an internet stream. Accordingly it is seen that the frame contains a network communication channel), **a telecast signal reception channel** (Paragraph [0060] of Janik discloses a digital photo frame being able to play data from a terrestrial broadcast. Accordingly it is seen that the frame contained a telecast signal reception channel), **and display means of an image received by the telecast signal reception channel** (Paragraph [0060] of Janik discloses a digital photo frame being able to play data from a terrestrial broadcast), Janik does not explicitly disclose **wherein the network communication channel comprises a message reception module to trigger the telecast signal reception channel upon receipt of an image availability message**.

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However, Sherr discloses this. Figure 10 of Sherr discloses a download manager, wherein it is seen that the user has the ability to select start download. The appearance of this window is seen to be information of the availability of the video. Paragraph [0024] of Sherr discloses the transfer may be accomplished in various ways, including broadcast systems, cable system, satellite systems, broadcast television system, broadcast digital television systems or internet. Accordingly when the system utilizes the broadcast systems to transfer the data, it is seen that such an indication to download would cause the device to prepare to receive utilizing appropriate means.

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the digital photo frame as disclosed by Janik, with using an image availability message as disclosed by Sherr. One of ordinary skill in the art would have been motivated to combine to apply a known technique on a known device ready for improvement. Janik's digital photo frame is disclosed to be able to receive video content that originated from a third party, as such it would be obvious to implement known video on demand techniques to support this feature.

25. As to **Claim 14**, Janik-Sherr discloses **a frame according to Claim 13, wherein the telecast signal reception channel has a key decoder** (Paragraph [0005] of Janik discloses utilizing various protocols that include additional encryption and security layers. Accordingly the digital photo frame would have to have appropriate decoders to handle the encryption and security layers).

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***Conclusion***

26. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 20040174327 A1 - Wireless digital picture display frame to Bowden,, George R. III et al.

US 20030011682 A1 - Method of sending digital photographs to Sellen, Abigail Jane et al.

US 20020152193 A1 - System and method for displaying images to Thompson, Robert S. et al.

US 20020126150 A1 - Wireless updateable digital picture frame to Parry, Travis J.

US 6975308 B1 - Digital picture display frame to Bitetto; Frank W. et al.

US 20040111749 A1 - Demanding a video program by using demand short message to Zhang, Jian et al.

US 20040003151 A1 - Method and system for streaming transfer of data between a digital camera and a host to Bateman, John D. et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN S. MAI whose telephone number is (571)270-5001. The examiner can normally be reached on Monday through Friday 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. S. M./

Examiner, Art Unit 2456

/Bunjob Jaroenchonwanit/

Supervisory Patent Examiner, Art Unit 2456